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INSIDE:

Cover Story

page

- 6 USPTO Supports Trademark Customers' Enforcement Efforts

Features

- 8 e-Government Initiatives... A Strategy for Better Customer Service
- 11 Trademark Customer Satisfaction Increases
- 12 Trademark Electronic Application System: Facts or Fiction?
- 17 New TEAS Forms
- 19 Electronic Payment Methods at the USPTO
- 21 Highlights of Legal Developments Affecting Trademark Practice Before the USPTO
- 24 Trademark Trial and Appeal Board Improves Customer Service
- 28 Assignment Recordation Services: FAQs
- 33 Trademarks Day... at the 25th Annual Patent and Trademark Depository Library Training Seminar
- 35 Trademarks: The Fingerprints of Commerce... Patent and Trademark Museum Opens New Exhibit

Departments

- 2 In Touch With the Under Secretary for IP
- 4 Message from the Commissioner for Trademarks
- 26 Helpful Hints... for trademark applicants
- 37 Faces of the USPTO

Office of Public Affairs
Washington, DC 20231
703/305-8341

James E. Rogan
Under Secretary of Commerce
for Intellectual Property and
Director of the United States
Patent and Trademark Office

Richard Maulsby
Director
Office of Public Affairs

Brigid Quinn
Deputy Director
Office of Public Affairs

Ruth Ann Nyblod
Managing Editor

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Comments and suggestions are welcome by e-mail to ruth.nyblod@uspto.gov.



James E. Rogan

*Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office*

I am pleased to take part in the third special edition of the *USPTO Today* on trademarks. The importance of federal registration and protection of trademarks is invaluable to our society. Since 1870, what is now the United States Patent and Trademark Office (USPTO) has been charged with the responsibility of providing federal registration of one of America's most valuable forms of intellectual property. Trademarks are truly the fingerprints of commerce.

Congratulations to the International Trademark Association (INTA) on another successful year dedicated to serving and protecting the interests of trademark owners. This year marks the 124th anniversary of the organization, and we are pleased that the site of this year's annual conference is our nation's capital. INTA has always taken a leading role not only in serving its members, but also in actively pursuing public policy matters concerning trademarks. The association's active role in educating business, media and the public on the proper use of trademarks is to be commended. Of equal importance is the role INTA has taken in supporting U.S. enforcement of anti-counterfeiting and piracy legislation.

Just as it is important to protect individuals against identity theft, we also must protect trademarks against piracy and counterfeiting. By issuing federal trademark registrations, the USPTO provides trademark owners with a powerful tool for defending their claims to ownership. Often times the mere existence of a federal registration is enough to deter illegal use of another's trademark. Nevertheless, companies in the United States continue to sustain tremendous losses abroad due to piracy and counterfeiting. It is one of my goals as under secretary of commerce for intellectual property to work closely with the administration to encourage our foreign trading partners to support strong intellectual property laws and enforcement systems. We must do all we can to stem the enormous losses U.S. companies suffer through piracy and ineffective enforcement.

The trademark organization has experienced tremendous technological growth since the time of the last special edition. The USPTO

provides one of the most, if not the most, technologically advanced trademark operations in the world. The Trademark Electronic Business Center provides trademark information that is only a mouse click away. Not only can applicants file applications electronically using TEAS, they also can check the status of applications and search the trademark database. In addition, visitors to the USPTO Web site can now view the *Official Gazette* and the TMEP online in a more readily available format. The information is available to both the independent entrepreneur as well as the large corporation.

USPTO is not only committed to developing the technology to provide e-filing, we also are on the road to show our customers how to use it. The commissioner for trademarks, Anne H. Chasser, and TEAS project manager Craig Morris, have been conducting a series of demonstrations and educational outreach programs on the many benefits of e-Government and the use of TEAS. Seminars have been offered in various cities throughout the United States including Ft. Lauderdale, Chicago, Boston, Houston, Atlanta, New York and Los Angeles and have been well attended. Electronic filings now comprise 31 percent of the total trademark filings of the USPTO. The agency's goal is to reach 50 percent electronic filing by the end of fiscal year 2002, and, with your help, I believe we can exceed that goal.

I extend a special invitation to all of you who have not tried electronic filing to do so. I firmly believe that once you have tried TEAS you will not go back to paper filings. Just ask some of our satisfied e-filers. For example, the trademark general counsel at General Electric has been so pleased with the benefits of electronic filing that the company now insists that all of its outside counsel file their trademark applications electronically. GE was the filer of the landmark 100,000th electronically filed trademark application.

There are many issues on the horizon in the future of trademarks. Issues affecting color mark applications, trademark dilution and geographic indications are just a few of the hot topics discussed in this special edition of the *USPTO Today*. Many of the issues have been raised before the Trademark Trial and Appeal Board, and the decisions rendered there will have potentially significant implications for future trademark applications.

The USPTO is proud of the contributions our organization makes to the global economy. The results of the trademark organization are visible in the marketplace and are a critical element in the promotion and protection of products and services worldwide. We will continue our commitment to world-class customer service and quality.

From the Commissioner for Trademarks



Welcome to the third annual *USPTO TODAY* special edition on trademarks. This year's edition features several articles related to our e-government initiatives. It is very exciting to see the rapid movement we are making towards providing a complete electronic trademark application and registration system! We are confident that our focus on e-Government will insure that we can provide you with the timely, high quality service you deserve.

Over the past year I have traveled around the country to promote our Trademark Electronic Filing System (TEAS). I have enjoyed meeting our customers and hearing valuable feedback on our electronic initiatives. Our staff is using the information we have received to develop electronic products that meet your needs, and I want to take this opportunity to mention some of the recent changes we have implemented.

First, we recently introduced an electronic change of correspondence address form in TEAS. The form permits you to notify us quickly and easily of your new address. Moreover, the new form will dramatically improve our customer service in this area. You will no longer face delays because of USPTO work backlogs or lost change of correspondence address papers. As soon as the electronic form is received by the USPTO, our databases are automatically updated to reflect the new address.

Second, in response to your requests, this year we enhanced TEAS to meet your needs for obtaining client signatures. Because the original method of obtaining a client's signature was somewhat cumbersome, the USPTO developed two new methods to simplify this process. Under the first method, the client can access a read-only, paragraph-style form in an email. No "downloading" of a

portable form is required. Under the second method, you can mail or fax the client a paper form for a traditional pen-and-ink signature, and then attach a scanned image of the document to your TEAS application.

Finally, this year we have modified the payment options for TEAS filings. Payment can be made by credit card, through a USPTO deposit account, or through electronic funds transfer. Deposit accounts are now checked for sufficient funds at the moment of filing. Further, recent upgrades to the USPTO finance system permit your financial service provider to display more information in your account statement, so you can associate a payment with a specific filing.

In addition to TEAS, we also are expanding the range of trademark information available at our Web site. This year we began posting the five most recent issues of the *Trademark Official Gazette* in a searchable format. I am also very pleased to announce that this year we updated two of our most frequently used manuals, the *Trademark Manual of Examining Procedure* and the *Manual of Acceptable Identifications of Goods and Services*. Both of these manuals are posted on the USPTO Web site in searchable formats.

As always, improving customer service is our highest priority. To better understand your needs, we continue to seek the advice of the Trademark Public Advisory Committee, which represents a diverse group of our customers. Rapid service is a longstanding customer priority and this year we have improved our processing times in many areas. For example, we reduced pendency on first office actions to three months.

In closing, I think that this is a very exciting time for the USPTO as we take full advantage of the wonderful opportunity for excellence that today's emerging technologies offer to all of us. Many of the articles in this special edition of the *USPTO Today* highlight some of our current and future initiatives, and I would welcome your feedback on our efforts.

Anne Schloss

USPTO Supports Trademark Customers' Enforcement Efforts

by Michael Shapiro, Office of Legislative and International Affairs

The story is all too familiar. While on vacation in a sunny foreign country, your teenage son stumbles on a real buy: Oakley sunglasses for only \$10, which he says sell in the United States for \$80. Everyone loves a bargain, so you agree to the purchase. But within a few days a lens has popped out and the paint begins to peel on the counterfeit Oakleys.

For manufacturers of products ranging from sunglasses to watches, and automotive parts to jeans, counterfeiting and product piracy are major problems. The International Anticounterfeiting Coalition estimates that counterfeiting costs the American economy \$200 billion a year and erodes consumer confidence in the quality of the real products. It's not just manufacturers that suffer. Everyone loses because intellectual property pirates do not invest in the development of new products, and they do not pay taxes.

Piracy and counterfeiting actually are two different types of intellectual property theft. To illustrate the point, suppose that a criminal manufactures fake brake pads and places a "General Motors" insignia (a registered trademark) on products and then sells them as if they were authentic. The unlawful theft of a General Motors protected product is an example of product piracy. The attempt to pass the fake GM parts off as the original is an example of counterfeiting. But what can be done about counterfeiting and product piracy?

Combating, investigating and prosecuting pirates and counterfeiters around the world is a complex and expensive process. Enforcing trademark rights involves customs, courts, prosecutors and police and the commitment of senior political officials. Effective trademark enforcement also requires raising public awareness that product piracy and counterfeiting impede the growth of legitimate, local product markets. Though the costs are high, businesses recognize that their trademark rights are only as valuable as their enforcement efforts. In a variety of ways, USPTO seeks to support the enforcement efforts of our trademark customers.

USPTO is working to improve the international legal framework for trademark enforcement, which has improved, but is still incomplete. The World Trade Organization's (WTO) Trade-Related Aspects of Intellectual Property Agreement (TRIPS) requires WTO members to provide for "effective enforcement" of intellectual property rights and incorporates a dispute settlement

procedure for a member to complain about WTO violations. The TRIPS agreement also includes detailed provisions on civil, criminal and border enforcement measures designed to protect the owners of intellectual property rights.

Over the last several years, the USPTO has assisted countries around the world in establishing adequate enforcement mechanisms to meet their obligations under the TRIPS agreement. In bilateral negotiations, USPTO is working closely with the United States Trade Representative to seek assurances from our trading partners of even higher levels of intellectual property enforcement than those set forth in the TRIPS agreement.

The USPTO is mounting enforcement training programs in the United States and abroad to improve the environment for intellectual property enforcement. For example, in cooperation with the World Intellectual Property Organization (WIPO), USPTO conducts a semiannual, "Academy of Enforcement of Intellectual Property Rights," which has provided training for customs, judicial and law enforcement officials from countries ranging from Albania to Zimbabwe. Finally, through the National Intellectual Property Law Enforcement Coordination Council, USPTO helps to coordinate and enhance enforcement training activities across a broad range of federal agencies.



Photo: Frankie Cox

The USPTO, in cooperation with WIPO, continues to offer its twice-annual Intellectual Property Enforcement Program to government officials from around the world. A Visiting Scholars Program also provides representatives of IP offices with a better understanding of the critical role IP protection plays in economic development.

e-Government Initiatives...

A Strategy for Better Customer Service

by Craig Morris, TEAS Project Manager

The United States Patent and Trademark Office (USPTO) continues to advance its e-government initiatives to serve more effectively its growing global customer base, by expanding and enhancing trademark information that can be accessed through the USPTO Web site (<http://www.uspto.gov>). The strategy is to replace paper filings and access to trademark information with electronic access, which would provide everyone trademark information 24 hours a day, seven days a week, regardless of someone's physical location.

Increasing the level of electronic communications will improve the agency's ability to serve all its customers with high quality, consistent results, by: (1) reducing the time to provide access to current information; and (2) improving the quality of the initial application, which in turn improves the quality of the data that is captured and shared in the publication and registration of trademarks. Through the USPTO Web site, all customers can view the same data that is used internally in the processing and examination of trademarks, and conduct nearly all their



trademark-related business electronically. Access to general trademark information, examination manuals, treaties, and laws and regulations is just a click away.

From one convenient location -- Trademark Electronic Business Center (<http://www.uspto.gov/web/menu/tmebc>) -- customers can use these electronic resources:

- **Trademark Electronic Search System (TESS)** to search all pending and registered marks, prior to submitting an application, from a database of over three million marks in both word and design formats.

- **Trademark Electronic Application System (TEAS)** to file eight forms directly over the Internet, paying by credit card, electronic funds transfer, or deposit account. The USPTO receives an average of 1,400 electronically-filed applications per week (approximately 31 percent of all filings). The goal is to receive 50 percent of trademark applications electronically by the end of 2002, and 80 percent of all communications electronically by the end of 2003.



Chevrolet emblem design owned by General Motors Corporation--one of top 10 electronic filers in FY 2001.

The agency will continue to expanded the award-winning TEAS to include additional forms and capabilities to minimize the collection of data by adopting XML standards, allowing customers more options to transact trademark-related business directly via the Internet.

- **Trademark Applications and Registration Retrieval (TARR)** to check status of applications and registrations. TARR was recently expanded to include additional data, and fortified with a new configuration to improve system availability.
- **Trademark Trial and Appeal Board Information System Index (BISX)** to check status of opposition and cancellation proceedings at the TTAB.

Other electronic resources on the USPTO Web site include:

- The **Third Edition of the Trademark Manual of Examining Procedure (TMEP)** has been updated with current office policy and procedure, and relevant case law reported prior to January 24, 2002, so it is now a complete examination resource. The USPTO will no longer print a paper TMEP. This will enable the agency to update the TMEP more frequently and regularly.
- The **Official Gazette (OG)** has been available in a searchable PDF format



Pampers Easy Ups and design owned by Procter & Gamble Company--a top ten electronic filer. Application filed via TEAS.

directly from the USPTO Web site since August 2001. The **OG** for the current week is now posted, plus the four prior weeks, for a rotating total of five issues. Previously, the **OG** was available only in paper form from the Government Printing Office or through the Patent and Trademark Depository Libraries. Copies of registration certificates were only available in paper at the USPTO or for a fee. Now, the entire publication and registration certificates are also available as a PDF file that can be downloaded via the Internet. The products are available more quickly to consumers, and the electronic versions are free.

Other e-Government initiatives either currently in place or under development include the following:

- **Trademark Information System (TIS)**, when fully developed, will create a totally electronic file management system that will eliminate the need for paper file handling in the processing and examining of trademark applications. A prototype demonstrating the basic concept of this system has been developed.
- The **Trademark Telecommuting (Work at Home) Program** allows approximately 40 percent of the eligible examining attorney workforce to perform the same work and access the same information technology systems from home as they do in the office. The program also has been expanded in pilot format to include paralegals. The USPTO has received recognition for its successful telecommuting program, namely, “The Commuter Connections Employer Recognition Award,” sponsored by the Metropolitan Washington Council of Governments, for creating a workplace where telecommuting produces a “smarter way to work.”
- **Hoteling Pilot:** Tests changes in the trademark telecommuting program, to simplify the administration of large numbers of telecommuting employees. An automated reservation system for scheduling time in the office for those who telecommute has been developed, with the objective of dramatically reducing office space requirements, and, therefore, office costs.
- The **Trademark e-Commerce Law Office Pilot:** Three e-commerce law offices accept and process electronically-filed applications, with the objective of centralizing all the functions within the receiving law office and relying on technology to streamline the process.

- The **Trademark Image Capture and Retrieval System (TICRS)** replaced microfilm as the office record of newly-filed applications and paper copies of newly-filed trademark applications filed in the trademark search library. Application data from paper-filed applications is captured through a manual optical character recognition process. Data from electronically filed applications is transferred to TICRS to create a complete electronic record of applications as they are filed. The system is being expanded to include the capture of incoming and outgoing correspondence, so that the office staff will have the up-to-date contents of the files available from their desktop computers. Data from TICRS will provide the capability for allowing examiners to conduct the initial examination from an electronic file and provide the source of data for TIS.
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Trademark Customer Satisfaction Increases

by Marty Rater, Office of Quality Management and Training

Since 1995, the United States Patent and Trademark Office (USPTO) has used customer satisfaction surveys to monitor customers' perceptions about the quality of its products and services and to identify areas for improvement. Approximately 2,500 trademark customers receive one of these surveys each year. The surveys are designed to measure customer satisfaction with the application process, the quality of examination, staff competence, staff responsiveness, problem resolution and other current-interest items such as electronic filing.

Survey results are made available to all USPTO employees and frequently serve as the basis for customer service training initiatives. Two key examples of how customer satisfaction data translate into improved customer service are in the area of responsiveness to telephone calls. Considerable resources, including customer service training for all trademark employees, have been geared toward trademarks employees' handling of telephone calls since 1996. At that time survey results showed that only 44 percent of customers were satisfied with getting their telephone calls returned within one business day, and only 54 percent were satisfied



with being promptly directed to the proper office or person. In 2001, survey results showed that 55 percent of customers were satisfied with having their calls returned in one business day, and 72 percent were satisfied with being promptly directed to the proper office or person.

From 2000 to 2001, overall satisfaction with the trademark operation improved from 65 to 70 percent satisfied. Several other items also posted significant improvements during this time frame. The most notable improvements were:

- Mail filing receipts within 14 days after receipt of application; 43 percent satisfied, up from 27 percent satisfied in 2000.
- Mail applicant's return postcard within three days; 62 percent satisfied, up from 49 percent satisfied in 2000.
- Process Section 8 requests within 30 days from filing date; 41 percent satisfied, up from 32 percent satisfied in 2000.
- Process Section 9 requests within 30 days from filing date; 38 percent satisfied, up from 30 percent satisfied in 2000.

These findings, and all other 2001 survey results, are currently available on the USPTO Web site at www.uspto.gov/web/offices/com/oqm. The 2002 survey will be mailed out to customers on or about May 1, 2002.

Trademark Electronic Application System: Facts or Fiction?

by Craig K. Morris, TEAS Project Manager

Myth (mith) n. 1. A fiction or half-truth. 2. A fictitious story, person, or thing.

Although frequent users of the Trademark Electronic Application System (TEAS) are already aware of the many benefits of electronic filing, the United States Patent and Trademark Office (USPTO) has come to recognize that many potential trademark filers are **not** filing electronically because of the many myths surrounding TEAS and electronic filing in general. Therefore, this article provides a high level overview of

the top 10 myths, in the hope that by disseminating proper information, these myths will be dispelled, and more customers will consider the electronic filing option.

Myth 1. *Signature methods are too cumbersome and burdensome.* Although the signature method originally deployed *was* cumbersome, the office has since introduced two new methods to simplify this process. Under the first new method, the client can access the form for signing directly from a hyperlink included in an e-mail generated upon completion of the form by the attorney, unlike under the original method, no “downloading” of any portable form is required. The client will see a “text form,” that being a narrative, paragraph-style format that only permits entry of the signature and date, and *not* the manipulation of any other data. The client will not have to see either the original application form used by the preparer of the application, or any sort of form with incomprehensible data tag elements.



GE script & design owned by General Electric Company. Last year, GE filed the 100,000th electronic trademark application.

The second method accommodates clients who cannot access Internet e-mail. Here, the attorney will complete the TEAS application, and then print out the text form. This paper copy can then be mailed or faxed to the client for a traditional pen-and-ink signature. Once the signed application is returned, the attorney can scan the document to create an image file of the signed declaration and to attach within the original electronic version of the application. The complete application can then be validated and filed electronically.

It also is important to note that an initial TEAS application *may* be filed electronically without *any* signature. This, however, is not desirable from the standpoint of efficiency of USPTO processing. A follow-up declaration with a traditional pen-and-ink signature may then be submitted, either as a preliminary amendment or in response to an office action.

Myth 2. *Payment methods are limited and/or problematic.*

Payment can now be made by one of three different methods: First, payment can be made via a credit card through a secure site that accepts MasterCard, Visa, American Express or Discover for “real time” processing, meaning that an application cannot be transmitted absent verification of valid credit card information.



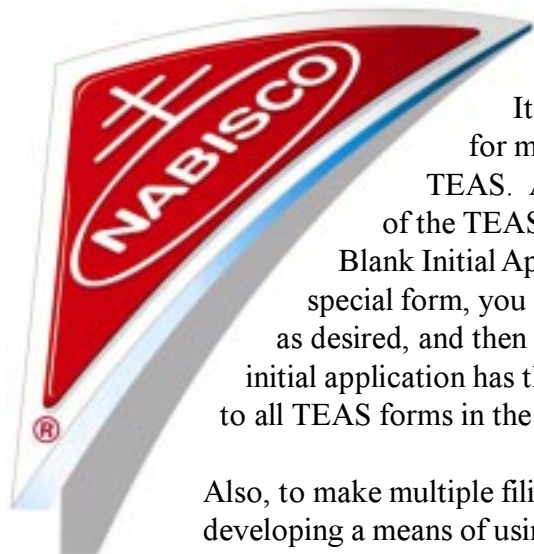
Mr. Clean design owned by Procter & Gamble Company--one of the top 10 electronic filers in FY 2001.

Second, payment can be made through an already-existing USPTO deposit account, which also will be processed in real time, so that

an application cannot be transmitted absent verification that sufficient funds exist within the deposit account.

Third, payment can be made through the Electronic Funds Transfer payment method, which allows you to send the USPTO a payment over the Internet, as easily as writing a check, by entering a bank account number and a bank transit routing number.

With recent upgrades to the agency's finance system, payment by any of these means should result in more information appearing on credit card statements, allowing for easier association of a payment with a specific filing. Although the USPTO will pass the accounting details, including serial number, to all banking institutions, not all banking institutions in turn provide this level of detail back to their customers.



*Nabisco design
owned by Nabisco
Brands Company--
one of top 10
electronic filers in
FY 2001.*

Myth 3. *There is no easy way to do many filings for the same client.*

It is, in fact, possible to create a template for multiple filings from the same client in TEAS. At the bottom left of the very front page of the TEAS site is a special icon for "Downloadable Blank Initial Application form." By accessing this special form, you can enter as little or as much information as desired, and then save it for later use. Currently, only the initial application has this feature, but the feature will be added to all TEAS forms in the future.

Also, to make multiple filings even easier, the USPTO is currently developing a means of using a different coding language (XML rather than HTML) for the various TEAS forms, so that standard data can be imported into the various forms quickly and easily. This should help address one of the primary criticisms of TEAS, namely that in-house law firm templates are currently more efficient.

Myth 4. *Electronic documents cannot be saved for later modification.* In TEAS, once you complete any application, you can save that application to your computer's local drive, as you would save any other document. The only difference is that the application will automatically be saved in a certain format (currently, HTML, and after future system enhancements, XML).

Saving the application simply requires clicking on the Download Portable Form button on the bottom of the TEAS Validation Page, accessed after you successfully complete the application by entering all fields required to receive an application filing date. Once saved,

you can modify the application at any time prior to submission, simply by pulling the file up from your local drive—in the same manner that you would pull up a regular word document to enter changes.

Myth 5. *The GIF and JPEG image formats required by the USPTO are difficult formats.* First, it should be noted that in many cases, no special equipment, beyond the proper versions of either Netscape or Internet Explorer, is required to use TEAS. That is, unless a special form drawing or specimen must be attached, no scanner or digital camera is required. Moreover, because a specimen is *not* required to receive a filing date, even a use-based initial application could be submitted through TEAS with no attachments. A traditional hard-copy specimen submitted could then be filed, either in the regular course of prosecution of the application or as a preliminary amendment.

As to GIF and JPEG images, both of these are standard image formats widely used in the computer and graphic design industries, and can easily be created using inexpensive entry level computer peripherals to create or scan images, namely scanners or digital cameras. Even so, the trademark operation is now exploring how to accommodate files in other formats, such as TIFF.

The USPTO also is considering creating, for a fee, an acceptable GIF or JPEG image file for the applicant, based on a paper or faxed submission. This would eliminate the need for filers to purchase any special equipment, and also would improve the quality of the drawings and/or specimens for TEAS filings.

Myth 6. *The user may not know if the USPTO received the electronic filing, particularly if the e-mail acknowledgment is not returned.* Many paper filers have come to rely on the return of a stamped postcard to confirm receipt by the USPTO of a mailed application. But, TEAS really does provide the assurance that you need that an application was successfully filed electronically. The e-mail acknowledgment is simply a follow-up courtesy that the USPTO provides. Within the actual filing session, a screen appears within seconds of completion of the filing process. It says “Success! We have received your application and assigned serial number _____.” This screen can be copied to save as an electronic



Miscellaneous Leaf design owned by Novartis AG Corporation—one of top 10 electronic filers. Application filed via TEAS.

record or printed out. If you do not see this success screen, then the filing did not go through. Again, this should occur within seconds of completion of the process, so no doubt should exist as to whether the USPTO received a particular filing.

Myth 7. *Electronic filings will not be properly docketed at the law firm, because the filing receipt will be sent to the e-mail address of the preparer of the application; and also that TEAS filings cannot be associated with a specific attorney docket number.* In reality, on the validation page you can specify *any* address to which you would like the e-mail acknowledgment to be directed. This *can* be the same address as that of the preparer of the application, or it could be a specially-created docketing address that will go somewhere else in the firm. Also, the form itself does provide, within the Attorney Information Section, a specific field for the entry of an attorney docket or reference number.

Myth 8. *The computer printouts look “unprofessional.”* To address previous criticism that the TEAS output was not “professional” looking, a new format was introduced for viewing the information, known as the “text” form. This can be accessed from an icon on the Validation Page, upon successful validation of the application. Because the “text” form presents the application data in a narrative, paragraph-style format, it is more user friendly and similar to what a law firm might prepare.

Also, the USPTO is now converting all TEAS forms from an HTML format to an XML format, which will be a more universally recognized format. The XML format will allow customers to communicate with the USPTO through documents that have whatever “look” the firm chooses, as long as the underlying XML tagging structure coincides with USPTO requirements.

Myth 9. *TEAS corrupts drawings, leading to rejections by the examining attorneys.* Upon reviewing the drawings that are the basis of these corruption claims, we have found that, in reality, the drawings, as originally prepared, did *not* comply with USPTO drawing standards. Instead, the originals included gray tones, rather than clean black-and-white images. Because the trademark operation now prepares the *Official Gazette* internally, it is imperative that submitted drawings comply completely with the drawing rules; all marks must consist of crisp black-and-white images with no gray tones.

Myth 10. *The applicant cannot simply “play around” on TEAS without fear of filing an application.* Actually, we encourage potential filers to get online and explore TEAS, as this is the only

way to become comfortable with electronic filing. Up until you hit the final button whereby you would authorize payment for the filing, you can simply close your browser at any time in the process, thereby stopping the application. Also, we suggest that in trying out the system, you simply enter an “X” in the data entry fields. This will still allow the application to validate, but will reduce the amount of information you must enter. Also, under the absolute worst case scenario, even if you file this application, you would later receive a fee refund, since you did not enter any “real” information to warrant granting of a filing date.



by Craig K. Morris, TEAS Project Manager

As part of the continuing effort to expand e-Government offerings, the United States Patent and Trademark Office (USPTO) recently enhanced the Trademark Electronic Application System (TEAS) to include two new forms -- the Change of Correspondence Address Form and the Response to Office Action Form. Both of these forms can be accessed through the front page of the TEAS Web site, at <http://www.uspto.gov/teas>.

Change of Correspondence Address Form

This form is to be used only to change a correspondence address, *not* to change either an actual Power of Attorney or Appointment of Domestic Representative, or the physical address of the applicant or owner (which requires a regular amendment). Only the applicant or the applicant's attorney may request a change of correspondence address, and the preparer of the form must confirm, through a check box on the form, that he or she is so qualified. Additionally, this form may not be used to change the applicant's name or to transfer ownership of an application or registration from one party to another. Those steps must be done through the Assignment Division.

To complete the form, you will first be asked in the initial Form Wizard to enter the serial number of the application. If the requested change is for an existing registration, you must still enter

the original serial number assigned to that filing; if not known, this can be accessed by entering the registration number in the Trademark Application and Registration Retrieval (TARR) system (a direct link to TARR is provided on the Form Wizard). To change more than one application or registration, you may enter multiple serial numbers, but not exceeding 20 serial numbers per request form, separating each with a space, with no punctuation.

Similar to an electronically-filed application, this form will not be “signed” in the sense of a traditional paper document. Instead, the signatory must enter any combination of alpha/numeric characters that has been specifically adopted to serve the function of the signature, preceded and followed by the forward slash (/) symbol. Acceptable “signatures” could include, for example, /john doe/; /jd/; or /123-4567/.

Response to Office Action Form

This form may be used either to respond to an office action based on an application or Statement of Use or to pay an additional fee after a phone call from the office (i.e., to enable an examiner’s amendment). However, you cannot use this form to respond to any actions from either the intent-to-use or post-registration areas. Forms for that purpose will be available in the future.

To have many of the fields of the form automatically completed using the trademark operation’s TARR database (based on your original filing), you should first enter the serial number and mark of your application in the initial Form Wizard. Answering all of the questions in the Form Wizard will create a response form showing only sections relevant to you.

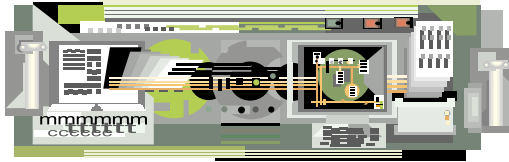
A declaration will automatically appear at the end of the actual form in each instance. A signed declaration is required if a red asterisk precedes a specific item listed on the form, *or* if the original application was submitted “unsigned.” The declaration must be signed by someone who is a “proper party to sign on behalf of applicant” under Trademark Rule 2.33. If not required, the declaration may simply be left unsigned. However, the response itself must always be signed. Similar to an electronically-filed application, the declaration and/or response will not be “signed” in the sense of a traditional paper document. Instead, the signatory must enter any combination of alpha/numeric characters that has been specifically adopted to serve the function of the signature, preceded and followed by the forward slash (/) symbol. Acceptable “signatures” could include, for example, /jane doe/; /jd/; or /7654-321/.

Electronic Payment Methods at the USPTO

by Michelle Piccard, Director, Office of Finance

Through the implementation of several electronic payment methods, the United States Patent and Trademark Office

(USPTO) Revenue Accounting and Management (RAM) system continues to support the trademark organization in its move to a fully electronic, e-government office. The RAM system has evolved to support a number of electronic payment methods that offer USPTO customers a variety of mechanisms to pay for goods and services over the Internet. Recognizing both the requirement for flexibility as well as the unique needs of its customers, the USPTO now accepts VISA, MasterCard, American Express, and Discover credit cards, Electronic Funds Transfer (EFT) with a unique identifier, and a deposit account payment methodology over the Internet.



The RAM system, recipient of a government agency award for excellence by the Post Newsweek Tech Media Group, publisher of *Government Computer News* and *Washington Technology*, is the USPTO's mission-critical, financial management system that provides subsidiary accounting for fee revenue and deposit accounts. Recognizing the emergence of e-Government, the original RAM system evolved to incorporate contemporary Web technology that has increased its usefulness for USPTO customers worldwide. RAM securely collects and processes electronic payments using Secure Socket Layer (SSL) encryption and was designed with a generic storefront interface to allow thousands of financial transactions to be entered automatically and processed without manual intervention.

During 1999, the USPTO integrated both the Trademark Electronic Application System (TEAS) and the Order Entry Management System (OEMS) Web storefront systems with RAM for collection of electronic payments over the Internet. TEAS allows customers to apply for trademarks electronically and pay for application fees online, while OEMS allows customers to purchase both patent and trademark documents and information online. It was at this time

that RAM emerged with its first electronic payment methodology, accepting credit cards over the Internet.

In November 2001, the USPTO enhanced RAM to transmit the application serial number/registration/order number (trademark copies) with its daily credit card file. This additional information will appear only on credit card statements of corporate, purchasing, and fleet credit cards. Customers are encouraged to coordinate with their financial institution or credit card company to ensure that this information appears on the monthly credit card statement.

Also in November 2001, RAM made a second electronic payment method available to trademark customers by allowing the use of EFT, with a unique identifier, to file trademark applications and order copies of trademark documents over the Internet. The unique identifier field allows customers to enter information to identify further the transaction. A check number or an attorney docket number are examples of data that may be entered in the identifier field. This information will be transmitted with the EFT payment and the application serial number/registration number/order number to the customer's financial institution. Each financial institution has its own policy regarding the display of this additional information on monthly bank statements, and customers are encouraged to work with their financial institution to obtain this benefit.

To use the EFT payment method, customers must create a user ID and password, and establish an EFT profile with name, address, bank account number, and bank routing transit number. The EFT account profile is securely stored so that the account owner is not required to enter the banking information for future transactions. If there is a change in the banking information, customers must update their account profile. Once an EFT payment is initiated over the Internet, the transaction flows through the Automated Clearing House (ACH) Network and funds are collected from the customer's bank account and transferred to the USPTO's bank account.

Trademark customers also may file trademark applications and order copies of trademark documents over the Internet using the deposit account payment method. To use this payment method, customers must have an access code and password. This information was mailed to each deposit account holder on record in November 1999, and is included in the Customer Information Package that is sent to customers who open a new deposit account with the USPTO. For further information on deposit accounts, please contact the Deposit Account Branch at (703) 305-4631, or e-mail: daadmin@uspto.gov.

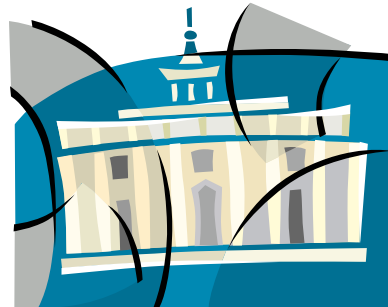
In the near future, RAM will be enhanced to accept multiple trademark filings in a single transmission and to provide consolidated statements for all payment types.

The RAM e-Government capabilities offer a 24/7 mechanism to conduct business with instantaneous payment capabilities using a variety of payment methods. The initiation of “anytime, anywhere” capabilities has improved customer service, by increasing public access, and will inevitably help control costs while enabling the agency to meet its future performance goals.

Highlights of Legal Developments Affecting Trademark Practice Before the USPTO

by James Toupin, General Counsel

Since INTA’s conference in San Francisco, both the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board (TTAB) have issued decisions with potentially significant implications for trademark applications. Most notably, the court made new law with respect to the adequacy of applications for color marks, functionality grounds for opposing registration of trade dress, and geographic misdescriptiveness grounds for opposing registration of marks containing geographic indications. The TTAB gave its first substantive guidance on the grounds for opposing registrations based on dilution.



The Federal Circuit decision in In re Thrifty, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001), provides guidance to applicants seeking to claim color marks. The court affirmed the TTAB’s decision refusing registration of the color blue as a service mark based on the applicant’s failure to provide an acceptable description of the mark.

Although Thrifty’s original application provided a drawing showing a building in dotted lines with an upper wall lined for color, its

proffered descriptions of its mark were much broader – such as “the color blue used in connection with the services set forth in the application” or “the solid color blue (Pantone Matching System 300).” The court ruled that the TTAB correctly determined that, pursuant to 37 C.F.R. § 2.52(a), the drawing submitted with the original application controlled, so that Thrifty’s original application was properly deemed to have been directed to the color blue on the wall of a building.

In affirming the refusal, the court also agreed with the TTAB that the evidence submitted to demonstrate acquired distinctiveness of a color may show consumer recognition with respect to certain objects (e.g., blue vehicle rental centers), but not for other objects (e.g., blue rental cars). While a word mark retains its same appearance when used on different objects, color is not immediately distinguishable as a service mark when used in similar circumstances.

Another case, Valu Engineering, Inc. v. Rexnord Corporation, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002), presented the court with its first opportunity to address functionality factors in light of the Supreme Court’s decision in TraFFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 121 S. Ct. 1255, 149 L. Ed. 2d 164 (2001). Reaffirming its own prior articulation of the test in In re Morton-Norwich Products, Inc., 671 F.2d 1332, 1340-41, 213 USPQ 9, 15-16 (CCPA 1982), the CAFC upheld the TTAB’s decision sustaining an opposition based on the functionality of claimed trade dress. Valu filed three applications seeking to register conveyer guide rail configurations, which Rexnord alleged were functional, and thus unregistrable, when used in areas of bottling and canning plants where machinery, including conveyer guide rails, is frequently washed with disinfectants and thus must be made of noncorrosive materials, such as stainless steel and plastic. Deciding an issue of first impression, the court affirmed the board’s decision to confine its functionality analysis to a particular use — in “wet” areas — rather than considering all potential uses for the marks.

In In re Save Venice New York, Inc., 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001), the court adopted the “related goods” test for deciding issues of geographic misdescriptiveness as to goods not made in the geographic location. The TTAB upheld the examiner’s refusal to register, as geographically misdescriptive, a composite mark consisting of the words THE VENICE COLLECTION, SAVE VENICE INC and an image of the winged Lion of St. Mark. The application identified a variety of goods, including potpourri, tableware made of precious and nonprecious metals, lamps, clocks, art prints, paper products residential furniture,

dinnerware, glassware, bedding and carpets. Of applicant's goods, only some of the glass products originated in Italy. The court held that substantial evidence supported the TTAB's finding that the VENICE COLLECTION portion of the mark dominated, such that the reference to Venice, Italy was of primary significance. The court also upheld the finding that consumers would directly associate some of applicant's goods with Venice, and, deciding an issue of first impression, that others of applicant's goods were sufficiently related to traditional Venetian goods to cause consumer confusion about the geographic source of the related goods.

In what may fairly be called a landmark case, the TTAB in Toro Co. v. Torohead, Inc., 61 USPQ2d 1164 (2001), issued its first decision on the merits involving trademark dilution. It held that opposer Toro Co., the owner of numerous registrations for TORO for lawn care equipment and other goods and services, failed to show that applicant Torohead, Inc.'s mark "ToroMR" and a bull's head design for goods described as "very low reluctance, thin film magnetic reading and writing heads for sale to original equipment manufacturers of high performance computer disk drives" would dilute Toro Co.'s mark. The board resolved a number of issues of first impression. It held that a dilution claim could be brought as to an intent-to-use application if the opposer shows fame in its mark before the date of application.

The opinion explains that the tests of the two required elements under the federal Anti-Dilution Act of distinctiveness and fame were not satisfied by the same evidence as would establish acquired distinctiveness and fame for trademark or likelihood of confusion purposes. The board held that the opposer must establish both the distinctiveness and fame of its mark and that a mark may be famous (as in a particular field) but not distinctive. Addressing the required fame showing, it held that to establish fame for dilution purposes, an opposer must show that the public's perception of the term had so changed that the term is primarily associated with the owner of the mark, even when considered outside the context of its particular goods and services. In this case, the board found evidence of advertising and product dominance in specific markets insufficient. Finally, the board found the two marks not confusingly similar for dilution purposes even if opposer had established the fame and distinctiveness of its mark.

Trademark Trial and Appeal Board Improves Customer Service

Compiled by the TTAB staff

The Trademark Trial and Appeal Board (TTAB) is focused on continuing to improve customer service, implementing a number of improvements to provide a wide range of information and to improve pendency. The TTAB is taking advantage of the latest technological advances to provide access to information through the Internet, and is moving toward complete electronic processing of filings with the board.

The TTAB has greatly decreased the pendency of motions and final decisions and has met or is on track to meet TTAB goals -- issuing final decisions and contested motion orders within 12 weeks after cases are ready for decisions. See the adjacent chart for current pendency progress.

TTAB Pendency			
	Goal		Pendency Dec. 31, 2001
Issuing Final Decisions on the Merits _____	12 weeks _____		11.5 weeks
Deciding Summary Judgment Motions _____	12 weeks _____		14.8 weeks
Deciding other Contested Motions _____	12 weeks _____		11.1 weeks

In addition, as noted in the accompanying sidebar, the TTAB's Web site provides a wide range of general and case-specific information to assist the public in TTAB proceedings.

The TTAB is moving rapidly toward complete electronic processing of papers in connection with TTAB proceedings through the pilot system, TTABIS, an electronic workflow and image database system. Using TTABIS, papers are scanned when filed, with a goal of having incoming records updated and available within 24 hours. TTABIS minimizes file movement and greatly decreases the number of lost and mismatched papers at the TTAB.

The TTAB hopes to provide public access to TTABIS proceedings files via computer terminals in the trademark public search room at 2900 Crystal Drive, Arlington, VA. later this fiscal year and via the Internet in the future. If the pilot is successful, TTABIS will be deployed throughout the TTAB.

Scanning documents involves a great deal of paper preparation. You can help facilitate the process by refraining from filing bound documents.

The TTAB plans to implement electronic filing by the end of the calendar year. First, parties will be able to file extensions of time to oppose. Over time, the TTAB will expand the system to allow electronic filing of other papers in connection with TTAB proceedings.

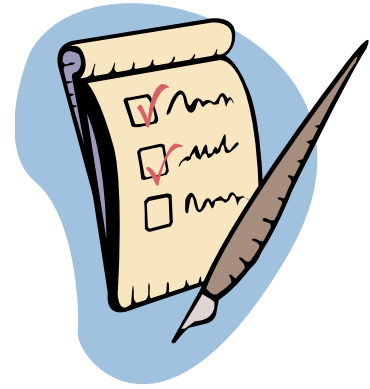
The Trademark Trial and Appeal Board's Web site, www.uspto.gov/web/offices/dcom/ttab/, is at the forefront of the board's efforts to provide useful information to the public. The information that is available through the Web site includes the following:

- A link to the BISX database, through which customers can obtain prosecution history information and status;
 - A link to the PTO Office of Finance Web site;
 - Summaries and texts of final decisions in both *inter partes* and *ex parte* board proceedings;
 - Fee information (forthcoming);
 - The Trademark Board Manual of Procedure;¹
 - Answers to frequently asked questions;
 - Suggested formats for oppositions and cancellations;
 - Trademark rule change notices;
 - Information concerning alternative dispute resolution;
 - The board's standardized form protective agreement; and
 - Information about employment opportunities at the PTO.
-

¹ In addition, relevant federal statutes and the Trademark Rules of Practice can be found at <http://www.uspto.gov/web/offices/tac/tmlaw2.html>.

HELPFUL HINTS

for trademark applicants



Avoid using “AND/OR” and “OR” in IDS

In general, avoid using the terminology “**and/or**” and “**or**” in your identification and recitation of goods and services. In most instances, the USPTO will regard the wording as “indefinite.” The rationale is as follows: “**Or**” suggests that the identification or recitation could be either of the items listed, but is not necessarily both. If the goods and services do not encompass both listed items, then both should not be listed. Moreover, if the identification does encompass both listed items then “**and**” is accurate.

Remember to sign your responses



All responses to USPTO office actions, even responses sent electronically, must be signed. Papers submitted to the USPTO electronically must be ‘signed’ using the same format accepted for electronically-filed applications. That is, the signatory must enter a combination of alpha/numeric characters that have been specifically adopted by the applicant, or the applicant’s representative, to serve the function of a signature. Said signature must be preceded and followed by the forward slash (/) symbol. For example, acceptable “signatures” could include: /john doe/; /jd/; and /123-4567/.

Provide dates of use for each class in multiple class applications

It is a requirement in filing multiple class applications (including statements of use) that the applicant set forth dates of first use and use in commerce **for each class**. TMEP section 1113.01 states: “If the dates are the same for all classes, the dates may be stated once, with the statement that the mark was first used on said dates on the goods or services in **all** the classes.” Absent such a statement, the examining attorney must make an inquiry as to whether the dates apply to all classes.

Do you have an examining question?

The Third Edition of the **Trademark Manual of Examining Procedure** (TMEP) is now available in PDF format at:
<http://www.uspto.gov/web/offices/tac/tmep/>.

Looking for information on post registration matters?

For information on post registration procedures, opposition procedures and cancellations, visit the USPTO Web site at:
<http://www.uspto.gov/web/offices/tac/tmep/pdf/1500.pdf>.

Do you need help phrasing your identification of goods or recitation of services?

The USPTO Trademark Manual of Acceptable Identification of Goods and Services is available online at:
<http://www.uspto.gov/web/offices/tac/doc/gsmmanual/IDS>.

FAQs...

Assignment Recordation Services

by Pat Rowe, Office of Public Records

What USPTO office records assignments and other documents affecting title?

The Assignment Services Division in the Office of Public Records (OPR) processes and records assignment documents for both patent and trademark properties. The division records about 300,000 documents annually.

What does it mean when a document is “recorded?”

Recordation is a ministerial function. The office neither makes a determination of the legality of the transaction nor the right of the submitting party to take the action. The office simply puts the information on the record without proffering anything about the transaction.

You mean that the USPTO records assignments without doing a title search or examining the document itself?

Yes, that is correct. All documents that meet the minimum requirements outlined in 37 CFR 3 are processed and recorded.

What are the requirements for recordation in 37 CFR 3?

Essentially the rules: (1) specify the minimum information about the transaction that must be submitted; (2) require submitters to send this information on a separate cover sheet; and (3) specify that submissions must be legible and of such quality to permit processing. The rules permit submission of true copies of assignment-related documents; original documents are not required; copies are preferred.

How is a document processed and recorded?

All assignments are processed through an image-based workflow management system called the Patent and Trademark Assignment System (PTAS). Documents first are scanned into PTAS.

Bibliographic data concerning the property and the parties involved in the transaction then is transcribed from the scanned image of the cover sheet and entered into the USPTO Assignment Historical Database. The images of the cover sheet and the document are automatically assigned reel and frame numbers by PTAS and put on searchable media (microfilm and CD-ROM). PTAS software then superimposes the assigned reel and frame numbers and the official recordation date stamp on the images. PTAS generates a “Notice of Recordation,” which is returned to the correspondence address on the cover sheet.

Why is the cover sheet so important?

All the searchable information going on the public record is transcribed directly from the cover sheet. The office does not compare the contents of the cover sheet to the underlying document to determine what data should be entered or to attempt to identify and resolve discrepancies.

You mean nobody reads the assignment document itself or any special instructions I may send to the office?

That is correct. Everything is transcribed, processed, and put on the record from the cover sheet.

Must I use the USPTO cover sheet forms, the PTO-1594 (Trademarks) and the PTO-1595 (Patents)?

These forms are not mandatory. However, the USPTO strongly encourages their use.

Why should I use the USPTO forms?

Completing the forms in their entirety ensures that all the required information for recordation has been sent to the office. The forms are available in PDF-fillable format on the USPTO Internet home page, thus making it quick and easy to prepare them in your office. Once they are received in the USPTO, the familiar style and format improves the accuracy of data transcription during processing.

If the USPTO performs a ministerial recordation function, why do I sometimes get documents returned to me as “non-recordable?”

Documents usually are returned as “non-recordable” for one of three reasons: (1) a critical piece of bibliographic information was

omitted from the cover sheet; (2) the document itself is illegible or of such poor quality that it cannot be scanned electronically; or (3) the correct fee was not paid.

What should I do when I get a “Notice of Recordation” back from the USPTO?

Carefully read the information printed on the notice and compare it to what you submitted on your cover sheet. The “Notice of Recordation” shows the data in the searchable Assignment Historical Database.

What if there is an error in the data on the “Notice of Recordation?”

If the error is a transcription or typographical error caused by the USPTO during the recordation process, simply circle the incorrect data, print the correct entry next to it, and fax the “Notice of Recordation,” with a copy of the cover sheet as it was first submitted, to the Assignment Services Division at (703) 308-7124. The Assignment Historical Database will be corrected and a new “Notice of Recordation” sent to you. There is no charge for this correction.

If the error originated during the preparation of either the cover sheet or the underlying document, then a complete new cover sheet, with the underlying document, should be sent to the Assignment Service Division as a “resubmission.” The correct fee (depending on the number of properties and transactions) must accompany the resubmission.

Why is it so easy to fix a USPTO error and yet all other errors must be corrected through a complete resubmission and payment of additional fees?

In a properly recorded document, there is a 100 percent match between the information in the Assignment Historical Database and the information on the cover sheet as displayed in the office’s microfilm and CD-ROM image files. If the office caused the error, it is a simple matter of two keystrokes to change the assignor’s name from “Smeth” to “Smith” in the Assignment Historical Database. Once the typo is corrected, the database will match the recorded images. However, if the submitting party put “Smeth” on the cover sheet in error, and the office transcribed it as directed, then the document must be reprocessed in its entirety to make sure that “Smith” appears both in the Assignment Historical Database and on the images displayed by reel and frame.

How long does it take to record an assignment?

For the last several years, the total turnaround time from receipt in the Assignment Services Division to dispatch of the recordation notice has varied between 50 and 60 calendar days.

Will my documents get recorded faster if I have them hand delivered to the Assignment Services Division or sent via overnight delivery service?

No. Regardless of how it arrives at the Assignment Services Division, a paper document is a paper document that requires extensive front-end handling and processing before being scanned into PTAS for recordation.

Are there other ways to get a document recorded in less time?

Yes, there are other, faster alternatives for the same price! *The key is not to send a paper document.*

The first alternative is to send documents by facsimile transmission directly to the PTAS image servers (PTAS-FAX); this avoids all the front-end processing and handling associated with paper submissions. Total processing time is 30 calendar days or less, with the “Notice of Recordation” being transmitted back to the originating fax number.

The second alternative is full electronic transmission of both the bibliographic information to build the Assignment Historical Database and the images of the document to be recorded. This option is currently available for patent-related properties through the Electronic Filing System (EFS). A similar functionality is under development for trademark properties and is scheduled to be available late in 2002. The time to process and record a fully-electronic assignment is usually 10 calendar days or less.

Other than the faster turnaround times, are there other advantages of PTAS-FAX and full electronic transmission?

The big advantage of using either one of these options is assured delivery and receipt of the document in the Assignment Services Division. This means the effective recordation date also is known, regardless of when the document is actually processed. Full electronic submission adds to this the sure and certain knowledge of what information will be recorded. With full electronic submission, the submitting party is in full control of the transaction because they enter the data that will appear in the Assignment

Historical Database and attach the document to their package – no chance for transcription errors or typos, and no mismatched documents caused by paper shuffling.

Where can I get information on how to use PTAS-FAX for either my patent or trademark assignments and the EFS for my patent assignments?

Information on PTAS-FAX and how to use it first was published in the USPTO *Official Gazette* (OG) on January 25, 2000, and then updated in the OG of August 15, 2000. The staff of the Assignment Services Division also can provide “how to” help by calling the division at (703) 308-9723 during business hours (8:30 a.m. to 5:00 p.m.).

Information on the EFS is available on the USPTO home page on the Internet. Click on “File Patents.” Information on the full electronic capability for trademark assignments will be posted on the USPTO home page as the system is developed and tested this year.

What about getting very critical documents recorded within a day or two? Can that be done?

Yes. The Assignment Services Division can provide “at cost” services to record assignment documents needed to support a pending commercial transaction or to meet a litigation deadline. Usually these recordation requests are bundled with an order for certified copies of the recorded document. Complete details on the availability and charges for “at cost” recordation services were published in the OG on May 27, 1997. The staff of the Assignment Services Division also can provide information on “at cost” services by calling the division at (703) 308-9723 during business hours (8:30 a.m. to 5:00 p.m.).

Why do I see different ownership information on the same property in various USPTO automated systems?

The expanding public availability of a number of USPTO systems and databases has caused some confusion about seemingly conflicting ownership information. Many of these new sources now open to the public were derived from automated systems designed to support USPTO staff in the prosecution and examination of patent and trademark applications and any resulting post-issuance/post-registration functions. Furthermore, new “ownership” information may not be updated in these systems until it is time for another step in the prosecution process. For example, ownership data shown in the Trademark Application & Registration Status

(TARR) system is updated only at the next significant step in the prosecution of the initial application or post-registration activity for registered trademarks.

Can the ownership information in these automated systems be linked and synchronized?

No. Remember that the USPTO business unit, either patents or Trademarks, has defined the term “owner” in these databases. These business units also determine the ground rules for if, when, and how the information is updated.

So what is the USPTO’s official record of ownership-related information?

The USPTO Assignment Historical Database is the official, authoritative source for ownership and related information. All title searches and abstracts of title are prepared from the records in the Assignment Historical Database.

When will I be able to search the Assignment Historical Database online through the USPTO Web site?

Web access for the public is planned for September 2003.

Trademarks Day...

at the 25th Annual Patent and Trademark Depository Library Training Seminar

by James C. Miller, Patent and Trademark Depository Library Program

Eleven trademark operation staff took part in the 25th Annual Patent and Trademark Depository Library (PTDL) Training Seminar on Wednesday, March 20, 2002.

“Trademarks Day” has been a regular and highly praised part of annual seminars since 1991, with many trademark staff participating. Even as early as 1982, most seminars included trademark presentations. In 1990, Jeffrey Samuels, then assistant commissioner for trademarks, announced the official change from “PDL” (Patent Depository Library) to “PTDL” (Patent and Trademark

Depository Library). Good-humored ribbing about “PTDL’s” followed.

Since 1996, Trademarks Day has been built around an entertaining theme. Commissioner for Trademarks Anne H. Chasser kicked off the formal ceremonies in this year’s “Reflection on the XIX Olympic Winter Games,” outlining the state of the trademark organization. TEAS project manager, Craig Morris -- the mastermind of the Olympic theme -- followed with the Olympic motto: “Faster, Higher, Stronger,” and an overview of the Trademark Electronic Application System (TEAS). Appropriate headgear and other props enhanced the mood. Paper cards at each attendee’s seat made a colorful “PTDL” display from the “stands.”



Photo: James Arshem

Craig Morris, TEAS project manager.

Continuing in an Olympic state of mind, examiners from six trademark law offices presented Web site, hands-on training classes at the Patent Academy called, “The Biathlon.” Trademark staff updated PTDL representatives on the new International Classification service classes 42, 43, 44, and 45, or “Men’s Figure Skating,” and the trademark registration process, or “Freestyle Skiing: the Moguls.” A short legislative update, “The Bobsled,” a discussion on geographical indications, “Olympic Judging,” and “The Five Tribes of Utah,” a discussion of tribal insignia followed.



Photo: James Arshem

Trademarks Day participants from left: Michael J. White, PTDL Program; Andrea Harland, New York PTDL; Commissioner Chasser; Craig Morris, TEAS project manager; Peter Warhit, San Francisco PTDL; Robin Gray, Cleveland PTDL; Chris Marhenke, Ft. Lauderdale PTDL; and Christine Kitchens, PTDL Program.

Everyone looks forward to an equally informative and interesting Trademarks Day next year.

Trademarks: The Fingerprints of Commerce

Patent and Trademark Museum Opens New Exhibit

by Ruth Nyblod, Office of Public Affairs

Trademarks are all around us. On an average day, we will encounter approximately 1,500 trademarks, and if we do our grocery shopping that day, the number increases to about 30,000.

A new exhibit, “Trademarks: The Fingerprints of Commerce,” opens May 17, 2002, in the Patent and Trademark Museum. The exhibit strives to educate the public about the value of trademarks not only to a company, but also to the consumer.



Like our own unique fingerprints that identify who we are, a company's trademarks identify its products or services in the marketplace. We, as consumers, make our choices based on the quality, reliability, and value we expect from particular products or services. We know what products to reach for on the shelf--or we pass over the ones that do not meet our needs or expectations--because we recognize their marks.

With so many similar products and services available worldwide, companies must depend on their trademarks to build consumer confidence. In that respect, trademarks are companies' most valuable assets.

Visitors to the museum also will learn to beware of counterfeit goods. Counterfeiting—the false marking of goods—has been a problem for centuries. Counterfeit products deceive the consumer and rob trademark owners billions of dollars in revenue. Consumers lose trust in products that are not what they appear to be, and hundreds of thousands of jobs are lost. Trademark owners use criminal prosecution and public education to discourage counterfeiting.

If the price of an item is too good to be true, or it is sold on the street without a warranty, it could be counterfeit. Distinguishing between counterfeit and genuine apparel and accessories may only require an examination of the stitching, fasteners, and quality of

material. Automobile and airplane parts or pharmaceuticals are much more difficult to detect... and more dangerous to the consumer. Frequently, a label on a counterfeit item sold on the street will resemble the registered trademark of a legitimate product with just a slight deviation in spelling or color.

Counterfeiting is theft, and governments around the world continue to seek solutions to the problem.

Another problem that faces a trademark owner is the public's misuse of a trademark. Once a trademark is registered, it can be renewed indefinitely if it is still being used in commerce. However, the owner must prevent the public from misusing the brand name to refer to all similar products. They do this by reminding the public, through advertising, that their brand names are trademarks and not just words. Some owners were unable to protect their marks after the public adopted them as common product names. For example: corn flakes, dry ice, aspirin, escalator, high octane, kerosene, lanolin, linoleum, mimeograph, nylon, raisin bran, yo-yo, shredded wheat, and trampoline.

Since 1870, the United States Patent and Trademark Office has registered trademarks, helping to protect the entrepreneur and consumer. Learn more about how the trademark system works and how trademarks affect our daily lives. Trademarks: Fingerprints of Commerce runs through the end of July 2002.

The Patent and Trademark Museum is located on the lobby level of Crystal Park Two, 2121 Crystal Drive, Arlington (Crystal City), VA. The museum is open Monday through Friday (except federal holidays), from 8:30 a.m. to 5:00 p.m., and the gift shop is open from 9:00 a.m. to 4:00 p.m.

A trademark is any word, phrase, symbol or device, or a combination of words, phrases, symbols, or devices, that identifies and distinguishes the source of the goods of one party from those of another. A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product.

An ® after a graphic, words, or other representation means that a product or service has been granted a federal trademark registration.

A ™ after a graphic, words, or other representation means that a trademark owner is claiming common law rights to a trademark, but a federal trademark registration has not been granted.

Faces of the USPTO



Photo: Joyce Ward

"The goal of the Trademark Assistance Center (TAC) is to provide quality customer service to both the internal and external customer. The TAC team is excited about the role we play in providing valuable information to the public as we transition into an e-government operation."

Dora Best joined the USPTO

in 1991 where she worked in the pre-examination section of the office. She later moved to Law Office 104 as an instruments clerk and then back to pre-examination as a classifier. In 1994, Dora was selected to assist in developing a one-stop customer service center, which became known as the Trademark Assistance Center. This office became a part of the trademark organizational structure in 1995. In 1997, she was selected to serve a three-year detail in the office of then assistant commissioner for trademarks Philip Hampton, and continued to serve under Commissioner Anne H. Chasser. After leaving the commissioners office, Dora served as a paralegal in the post-registration division of the trademark operation. In November 2001, she was appointed to the position of supervisor for TAC.

Dora is currently a student at Trinity College and a candidate for Human Resources Certificate Program at the University of Virginia. In her spare time, Dora enjoys reading, listening to jazz and spending time with her husband and three sons.



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“As we continue to evolve into a fully-electronic environment there are tremendous challenges ahead. However, I am confident that trademarks has the resources to meet every challenge and continue to provide world class service.”

Ron Williams joined the USPTO in October 1981 as an examining attorney in then Law Office 6, where he examined all service mark applications. He served as vice-president of the National Treasury Employees Union, NTEU 245. In August 1988, Ron was selected to serve as managing attorney of Law Office 101, the foods and beverages office. In 1998, he was appointed to the position of senior trademark administrator. In September 2001, Ron was appointed to the Senior Executive Service as a group director.

Ron is a 1976 graduate of Hampton Institute and a 1980 graduate of the University of Richmond Law School. In his spare time he referees high school and college basketball.

“This is a very exciting time at the USPTO. As we transition to an e-Government environment, many of our perennial problems such as lost papers and data entry errors will disappear, and we will be able to focus on providing our customers with the high quality examination and service they deserve.”

Sharon R. Marsh

is the administrator for trademark policy and procedure in the trademark operation. She joined the USPTO as a trademark examining attorney and served as a senior attorney and as a managing attorney before assuming her current position. In 1991, as a participant in the Department of Commerce’s Science and Technology Fellowship Program, Sharon worked for the Subcommittee on Technology and the Law of the Senate Judiciary Committee. Sharon is a graduate of Duke University and the Emory University School of Law.



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